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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/627,270	04/04/1996	HIDEAKI TOJO	SKO-104-A-1	8796

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CARRIER, BLACKMAN & ASSOCIATES  
24101 NOVI ROAD  
SUITE 100  
NOVI, MI 483753248

EXAMINER
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JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/627,270

Applicant(s)

TOJO ET AL.

Examiner

Marc Jimenez

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20,27,30-33 and 37-57 is/are pending in the application.
- 4a) Of the above claim(s) 49-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20,27,30-33 and 37-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/15/05 has been entered.

### ***Election/Restrictions***

2. Applicant's election with traverse of Group I, Claims 20, 27, 30-33 and 37-48 in the reply filed on 12/15/05 is acknowledged. The traversal is on the ground(s) that the claims are drawn to different aspects of a single inventive concept and a search of the entire application would not place a serious burden on the Examiner. This is not found persuasive because as noted in the restriction requirement, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require "applying paint to a plurality of vehicle body components" or "wherein no additional paint is applied to the vehicle after the protective coating has been applied" as recited in the subcombination. The subcombination has separate utility such as for use in a combination other than one having "press-forming panel parts from a sheet metal and welding the panel parts together" as recited in the combination. In addition, it would be a serious burden to search both groups because they entail different fields of search and different art rejections would have to be applied.

The requirement is still deemed proper and is therefore made FINAL.

***Drawings***

3. The substitute drawing of figure 1 was received on 12/15/05. This drawing is approved.

***Specification***

4. The amendment filed 3/27/03 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows (see also last office action mailed 9/12/03):

(a) the LAPGUARD L is a peelable paint, and

(b) that the protective film formed in said peelable paint coating step has a sufficient thickness to protect the paint finished automobile body from scratches during the assembling.

Applicant is required to cancel the new matter in the reply to this Office Action.

Applicant states that the original specification inherently or expressly discloses the above features, however, Applicant has not provided evidence where these features can be found in the original disclosure. Therefore, the objection to the specification amendment is maintained herein.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 20, 27, 30-33 and 37-48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan et al. (US5604282) in view of Omori et al. (US4727232) or vice versa.

Regarding claims 20, 47 and 48, Grogan et al. teach painting an automobile body so that the automobile is paint-finished (col. 1, line 59 and 66-67 and col. 2, line 21), assembling an engine and functional parts into the paint-finished automobile body to thereby produce an assembled automobile (col. 1, lines 54-58) col. 2, line 4), and after the automobile is completely manufactured performing a final inspection of the assembled automobile (it is clearly inherent that when manufacturing vehicles, a final inspection is performed before the vehicles are shipped), wherein the method further includes, between the painting and the assembling steps, coating a strippable paint on an exterior painted surface of the paint-finished automobile body (col. 5, lines 49-51) to thereby form a protective film on the painted surface, and at least the assembling step and the final inspection step are carried out while the protective film of the strippable paint remains coated on the painted surface of the paint-finished automobile body (col. 5, lines 51-58).

Grogan et al. states “A need exists for a water-removable coating composition to protect the automobile against weathering, contamination from the atmosphere, chemical attack or accidental damage during manufacturing, handling, storage and transit.” (col. 1, lines 54-60). The manufacturing would include the assembling of the engine and functional parts into the automobile body. Also, in col. 2, lines 46-48, Grogan et al. states “Thus, there is a need from a tough film that is inexpensive to apply and remove and one that can remain on the vehicle until

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the consumer purchases the car.”. Also, in col. 10, lines 4-7, Grogan et al. states “During assembly of the vehicle, the paint finish is inadvertently dinged, chipped and scratched as the workers use their tools to assemble the various parts of the vehicle.” (This applies to claim 46). Therefore, the protective film **remains** on the vehicle during assembly, during transit, and is only removed at the final destination. Before vehicles are placed in transit, there is a “final inspection”, for example, because each vehicle must be checked to ensure that the proper vehicle is transported. (These teachings read on claim 45).

**Applicant has included the new limitation “pretreating the paint-finished automobile body, including substeps of washing the paint-finished automobile body and dehydrating the paint-finished automobile body” in claim 20 in an attempt to overcome the previous rejection.**

Grogan et al. fails to teach that the automobile parts are formed by press forming panel parts from sheet metal and welding the panel parts together to form an automobile body. In addition Grogan et al. do not specifically teach washing the paint-finished automobile body and dehydrating the paint-finished automobile body.

Omori et al. teach that surfaces of an automobile vehicle body are conventionally formed by press forming, welding and painting (col. 1, lines 12-59).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Grogan et al. with the steps of forming by press forming and then welding them, in light of the teachings of Omori et al., in order to securely fasten parts together and in order to accurately form the desired contour of the vehicle.

In the alternative, and also based on the teachings of the two references, it would have been obvious to one of ordinary skill in the art, at time of the invention, to modify the method of Omori et al., to coat the automobile with a peelable paint after it has been painted, in order to protect the vehicle from damage during subsequent mechanical operations performed on the product, as taught by Grogan et al.

Regarding the limitation “pretreating the paint-finished automobile body, including substeps of washing the paint-finished automobile body and dehydrating the paint-finished automobile body”, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention to have washed a paint-finished body and dehydrating the paint-finished automobile body (either by air drying or by using blowers to dry) prior to applying the strippable paint on an exterior paint finished surface, in order to provide a clean surface that the protective, strippable paint could adhere to. It is obvious to clean a paint-finished surface that needs to be protected by a strippable paint. One of ordinary skill in the art would not apply a strippable paint to a paint-finished surface that may be dirty, otherwise, the paint-finished surface will be scratched during application of the strippable paint onto the paint-finished surface.

Regarding claims 27 and 41-44, Grogan et al. is considered to teach a preliminary drying of the strippable paint as the strippable paint is first dried. There is a non-preliminarily drying the preliminarily dried, strippable paint using a second drying means in the wind tunnel (col. 5, line 48).

Regarding claim 30, the use of infrared radiation in conjunction with hot air is a well known expedient to drying coatings and official notice is taken of such. Consequently, it is considered that it would have been obvious to one of ordinary skill in the art, at the time of the

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invention, to modify the combination as explained above so as to dry the peelable coating by infrared radiation in conjunction with hot air.

Regarding claims 31, 32 and 40 neither Grogan et al. nor Omori et al. explicitly teach that the peelable paint is stabilized prior to drying and that this is done at ambient conditions. It is the examiners position that ambient conditions would have been the most readily apparent and convenient condition to one of ordinary skill in the art, requiring no modification of the surrounding environment. Consequently, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to apply peelable paint under ambient conditions because ambient conditions would have been the most constant and time effective conditions available to do so. Any point prior to drying at which the peelable paint coated product sits at ambient (for any period of time) reads on the claimed stabilizing treatment.

Regarding claims 33 and 37, Grogan et al./Omori et al. teach the invention cited with the exception of the drying steps being performed at elevated temperatures. However, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided the invention of Grogan et al./Omori et al. with drying at elevated temperatures, in order to facilitate faster drying of the protective film.

Regarding claims 38 and 40, the strippable paint is water based (col. 5, line 31 of Grogan et al.).

7. **Claims 20, 27, 30-33 and 37-48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomioka et al. (US5428880) in view of Grogan et al.

Tomioka et al. teach press forming panel parts (col. 4, line 29) from a sheet metal and



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welding the panel parts together (col. 4, line 29) together to form an automobile body, the method comprising the steps of: painting the automobile body so that the automobile is paint-finished **7** (figure 1, “priming” is considered “paint-finished”), assembling an engine and functional parts into the paint-finished automobile body to thereby produce an assembled automobile body (col. 4, line 42), and after the automobile is completely manufactured, performing a final inspection of the assembled automobile (it is clearly inherent that when manufacturing vehicles, a final inspection is performed before the vehicles are shipped), wherein the method further includes, between the painting **7** and the assembling steps **MS**, pretreating the paint-finished **7** automobile body, including substeps of washing the paint-finished automobile body **8** and dehydrating **9** the paint-finished automobile body.

Tomioka et al. teach the invention cited with the exception of coating a strippable paint on an exterior painted surface of the paint-finished automobile body to thereby form a protective film on the painted surface and at least the assembling step and the final inspection step are carried out while the protective film of the strippable paint remains coated on the painted surface of the paint-finished automobile body.

Grogan et al. teach painting an automobile body so that the automobile is paint-finished (col. 1, line 59 and 66-67 and col. 2, line 21), assembling an engine and functional parts into the paint-finished automobile body to thereby produce an assembled automobile (col. 1, lines 54-58) col. 2, line 4), and after the automobile is completely manufactured performing a final inspection of the assembled automobile (it is clearly inherent that when manufacturing vehicles, a final inspection is performed before the vehicles are shipped), wherein the method further includes, **between the painting and the assembling steps, coating a strippable paint on an exterior**

**painted surface of the paint-finished automobile body (col. 5, lines 49-51) to thereby form a protective film on the painted surface, and at least the assembling step and the final inspection step are carried out while the protective film of the strippable paint remains coated on the painted surface of the paint-finished automobile body (col. 5, lines 51-58).**

Grogan et al. states “A need exists for a water-removable coating composition to protect the automobile against weathering, contamination from the atmosphere, chemical attack or accidental damage during manufacturing, handling, storage and transit.” (col. 1, lines 54-60). The manufacturing would include the assembling of the engine and functional parts into the automobile body. Also, in col. 2, lines 46-48, Grogan et al. states “Thus, there is a need from a tough film that is inexpensive to apply and remove and one that can remain on the vehicle until the consumer purchases the car.”. Also, in col. 10, lines 4-7, Grogan et al. states “During assembly of the vehicle, the paint finish is inadvertently dinged, chipped and scratched as the workers use their tools to assemble the various parts of the vehicle.” (This applies to claim 46). Therefore, the protective film **remains** on the vehicle during assembly, during transit, and is only removed at the final destination. Before vehicles are placed in transit, there is a “final inspection”, for example, because each vehicle must be checked to ensure that the proper vehicle is transported. (These teachings read on claim 45).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Tomioka et al. with coating a strippable paint on an exterior painted surface of the paint-finished automobile body to thereby form a protective film on the painted surface and at least the assembling step and the final inspection step are carried out while the protective film of the strippable paint remains coated on the painted surface of the

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paint-finished automobile body, in light of the teachings of Grogan et al., in order to protect the surface of the automobile body from damage that may be caused during the assembly process or during transit.

Regarding claims 27 and 41-44, Grogan et al. is considered to teach a preliminary drying of the strippable paint as the strippable paint is first dried. There is a non-preliminarily drying the preliminarily dried, strippable paint using a second drying means in the wind tunnel (col. 5, line 48).

Regarding claim 30, the use of infrared radiation in conjunction with hot air is a well known expedient to drying coatings and official notice is taken of such. Consequently, it is considered that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the combination as explained above so as to dry the peelable coating by infrared radiation in conjunction with hot air.

Regarding claims 31, 32 and 40 Grogan et al. does not explicitly teach that the peelable paint is stabilized prior to drying and that this is done at ambient conditions. It is the examiners position that ambient conditions would have been the most readily apparent and convenient condition to one of ordinary skill in the art, requiring no modification of the surrounding environment. Consequently, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to apply peelable paint under ambient conditions because ambient conditions would have been the most const and time effective conditions available to do so. Any point prior to drying at which the peelable paint coated product sits at ambient (for any period of time) reads on the claimed stabilizing treatment.

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Regarding claims 33 and 37, Grogan et al. teach the invention cited with the exception of the drying steps being performed at elevated temperatures. However, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided the invention of Grogan et al. with drying at elevated temperatures, in order to facilitate faster drying of the protective film.

Regarding claims 38 and 40, the strippable paint is water based (col. 5, line 31 of Grogan et al.).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 20, 27, 30-33 and 37-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8, 63, 65, 9, 36-38, 12 and 66 of copending Application No. 08/398,881.

See last office action where the double patenting rejection was applied at page 10 of the

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office letter mailed 9/12/03. Applicant has not addressed the double patenting rejection in the last office.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

10. Applicant's arguments with respect to claims 20, 27, 30-33 and 37-48 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's argument with respect to the restriction requirement has been addressed above in paragraph 2.

12. Applicant's argument with respect to the objection to the specification has been addressed above in paragraph 4.

13. Applicant's argument with respect to the newly added limitations to claim 20 has been addressed in the rejections above.

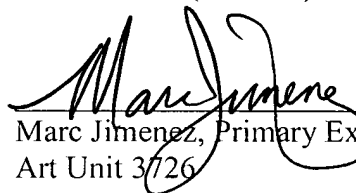
14. Applicant has not properly rebutted the double patenting rejection or provided a terminal disclaimer, therefore this rejection is maintained.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (571) 272-4530. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Nguyen can be reached on (571) 272-4491. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Marc Jimenez, Primary Examiner  
Art Unit 3726

MJ  
2-22-06